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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/833,301

Filing Date: April 10, 2001

Appellant(s): PETRUSHIN, VALERY A.

Sanders N. Hillis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 15, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient because Appellant's specification is directed towards monitoring telephone call conversations between agents and customers in a call center environment in which an entire conversation between a certain agent and a certain customer may be recorded or only one portion of the conversation may be recorded, if a detection of monitoring condition is satisfied (Appellant's specification, page 26, lines 21-23). The Examiner also respectfully disagrees with Appellant, as already discussed in Advisory Action mailed May 26, 2004, where Appellant indicates that the claimed language is supported in Appellant's specification (shown on pages 4 and 5 of Appeal Brief).

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief **is** correct.

(8) *Prior Art of Record*

6,542,602 ELAZAR 4-2003

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to support the step of pre-recording a first speech portion of a telephone call received by an agent and determining whether said first speech portion satisfies a monitoring condition. What Appellant's specification disclosed on page 26, lines 21-23 or "throughout the specification" is monitoring the level of nervousness of a person and including an alarm, when it is set off, to trigger a recording device to begin recording the conversation. Appellant's specification is silent on a first portion of the conversation being pre-recorded and that first portion being tested before a second portion is to be recorded.

It is critically important to note that the terms "pre-recording", "first speech portion" and "second speech portion" were never part of Appellant's original specification or claims. These

terms were copied from the Elazar patent and introduced for the first time in an amendment filed on January 27, 2004.

Claim Rejections - 35 USC § 102

2. Claims 2-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Elazar (U.S. Patent No. 6,542,602).

It should be noted that the effective date of the new claimed invention is the date of amendment filed on January 27, 2004 since support for all claimed limitations is not found in the specification as originally filed.

Regarding claims 2-4, see column 3, line 50 through column 4, line 30.

(10) Response to Argument

On page 8 of the Appeal Brief, last paragraph, Examiner agrees with Appellant that Appellant's specification describes that the alarm could begin the recording if the conversation is not already being recorded. However, Examiner disagrees with Appellant that it inherently follows that the lack of an alarm could end the recording of a conversation already being recorded. The specification fails to explain how the system would recognize when the lack of an alarm has happened during the conversation in order to end recording. Appellant's specification (page 26, lines 21-23) states "The alarm could also be connected to a recording device which would begin recording the conversation when the alarm was set off, if the conversation is not already being recorded" [Emphasis added]. As the broadest interpretation with the lack of an alarm, if the conversation is already being recorded, the conversation continues to be recorded

while waiting for the alarm to be set off, or if the conversation is NOT already being recorded, the conversation continues without being recorded while waiting for the alarm to set off. In other words, Appellant's specification shows that, with the lack of an alarm, the conversation is recorded as a whole when the conversation is already being recorded or not at all when the conversation is not already being recorded.

On page 9 of the Appeal Brief, second paragraph, Appellant argues that step b) in claims 2-4 includes no limitations, such as "said pre-recorded first speech portion," to indicate that it is a recording that is used to determine whether a monitoring condition is satisfied. In fact, Examiner believes that "said first speech portion" in step b) is, and must be, the same as "said pre-recorded first speech portion". The term "said" in "said first speech portion" means that the "first speech portion" of step b) is the "first speech portion" which was pre-recorded in step a). As the matter of time, if the same "first speech portion" is used in step a) for pre-recording and also used in step b), then "determining" in step b) should logically be changed to "pre-determining". Since the limitation "determining" (not "pre-determining") is used in step b) follows by "pre-recording" used in step a), then with the broadest interpretation, "said first speech portion" in step b) must be "said pre-recorded first speech portion". Further, Appellant asserts that "If the specification does not require a limitation, then that limitation should not read into the claims from the specification". It is noted that the Examiner's position is not that the Appellant's assertion, but rather the specification, fails to support the claimed language.

Last paragraph on page 9 of the Appeal Brief, Appellant states that steps a) and b) do not include any limitation indicating that steps a) and b) must occur sequentially, simultaneously (in "real time"), or in any particular order. However, the Examiner respectfully disagrees. The

steps in a method claim need not be restricted to being performed in any particular order where the claim nor the specification requires such a narrow construction of the claim if the steps are not followed by an sequential order in each step (e.g. steps a), b) and c)). The steps in a method claim are followed by a sequential order in each step are required to be performed in that particular order. Appellant might be right in some cases, but not in this case. Accordingly, the claimed language used in step a) occurs and then step b) occurs using the result in step a) is natural meaning of the language and by itself restrict the scope of claims 2-4.

On page 10 of the Appeal Brief, Examiner agrees with Appellant that as is well known, a conversation is a sequential stream of words in which some words precede other words. For “the broadest reasonable interpretation of the claim” that the Appellant relies on, Appellant may be right that the recording of conversation may include a first portion (a word or group of words) and a second portion (another word or group of words). However, those first and second portions of Appellant are only one portion and differ from the meaning of first portion (is pre-recorded in step a) and second portion (is recorded if said first portion satisfies a monitoring condition in step b) in claims 2-4 where the claims is constructed based upon the logical and sequential occurrence of steps a) through c). At its best, the Appellant’s specification with a condition includes recording the conversation as a whole or “begin to record” the last part of conversation and such recording never has two separate portions as defined in steps a) through c) in claims 2-4. Therefore, the Examiner fails to find support in Appellant’s specification to for the limitations of claims 2-4.

Conclusion

Examiner's position is that step (a) of "pre-recording a first speech portion" occurs **first**, and **then** this "said first speech portion", which was pre-recorded in step (a), is analyzed in step (b) for "determining whether said [pre-recorded] first speech portion" satisfies a monitoring condition; and if so", **then** step (c) of "recording at least a second portion" will follow step (b). The above is not supported by Appellant's specification.

In support of the Examiner's position, the following three supporting items are introduced: First, one cannot ignore and cannot argue **the fact** that the above interpretation was the **only** interpretation that the examiner had in mind throughout the prosecution of the Elazar patent application, which matured into a patent.

Second, one cannot ignore and should not argue the above interpretation because the Elazar's claims were always interpreted by examiner in light of the Elazar's specification which clearly states that:

"A [first] portion of the audio ... may be pre-recorded **prior to and in support of** performing step 200, in which the monitoring condition is tested" [Emphasis added] (see Col. 8, lines 66-67 and col. 9, lines 1-11)

Third, examiner's interpretation is logical because the unconditional "pre-recording" occurs prior to the conditional step of "recording", which may or may not occur. The "pre-recording" in step (a) will always and unconditionally occur, while the separate and conditional "recording" of step (b) may or may not occur. It is believed that labeling the steps as (a), (b) and (c) is further

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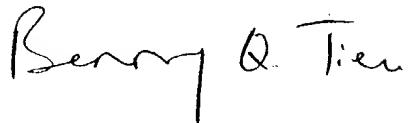
evidence that the steps are, indeed, sequential. Normally, steps are not labeled. Actually, a portion of the speech has no beginning or end, remains nameless, and will only carry the label "first speech portion" after it is "pre-recorded". Once it is "pre-recorded", then, and only then, it becomes defined as a "first speech portion".

Appellant's conclusion that steps (a), (b) and (c) need not occur "sequentially" or in any particular order (e.g., page 9 of the brief) is absolutely untenable. One cannot start with step (c) because step (c) requires step (b). If one were to start with step (b), what would one consider to be "said first portion of speech"? Why does Appellant use the term "pre-record" if there is no particular order for the steps? Again, Appellant's interpretation is untenable, illogical, contrary to the explicit teachings of Elazar, and contrary to interpretation that the examiner has consistently held throughout the prosecution of the Elazar application and Appellant's application.

Since Appellant's specification fails to support the newly added claims 2-4, the effective date of the new claims is the date of amendment filed on January 27, 2004. Therefore, the rejection under the 35 U.S.C. 102(e) is not moot.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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BQT
November 29, 2004

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